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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,274	07/23/2001	Michael J. Siwinski	82414ATHC	4393

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EXAMINER	
RAMSEY, KENNETH J	
ART UNIT	**PAPER NUMBER**
2879	

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/911,274	SIWINSKI ET AL.	
	Examiner	Art Unit	
	Kenneth J. Ramsey	2879	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) 17-25 is/are allowed.

6)☒ Claim(s) 1-16 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, 7, and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 8, 9, respectively of U.S. Patent No. 6,424,094. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are broader than the corresponding patent claims thus clearly making the pending claims obvious as lack of novelty is the epitome of obviousness.

Claims 9, 10, 12, 15 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 8, 9, respectively of U.S. Patent No. 6,424,094. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are clearly the obvious method of manufacturing the product of the respective patent claims.

Claims 3 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,424,094 (Feldman) in view of Kubes et al 6,035,180. Patent claim 2 discloses the electroluminescent touch screen device having an EL display on a first side of a substrate and a touch screen on the opposite side of the substrate. This differs from the claimed invention in that the claimed invention employs a top side EL device on a first substrate which is laminated with a protective sheet and by forming the touch screen on the protective sheet. Kubes, column 11, lines 8-23 discloses this latter configuation to be a desirable configuration because it places both the EL device and the touch screen on the same side of the substrate thus allowing a wider angle display without offset of the touch screen from the display. Thus it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to form the EL device of patent claim 2 as a top emitting EL device and to apply the touch screen elements to the user side of the protective sheet to allow a wider viewing angle.

Claims 5 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,424,094 (Feldman) in view of Colgan et al 6,1777,918. Patent claim 2 differs from the claimed invention in that a capacitive touch screen rather than a resistive or other touch screen, each of which is within the scope of patent claim 2. Also, it is disclosed at column 2, lines 1-13 that capacitive touch screens have a greater light transmix=ssion than resistive touch screens. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to employ a capacitive touch screen in the display

of patent claim 2 since some companies, e.g., IBM have developed such a touch screen as an alternative to the resistive touch screen for improved light transmission. Note also that column 14, lines 18-34 teach that the display can be other than a liquid crystal display of the main example of Colgan.

Claims 6 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,424,094 (Feldman) in view of the September 1999 brochure by Elo company entitled "IntelliTouch Surface-Wave Touchscreens". Patent claim 2 differs from the claimed invention in that a acoustic wave type touch screen rather than a resistive or other tyoe touch screen, each of which is within the scope of patent claim 2. Also, it is disclosed by Elo that Surface Wave acoustic touch screens have high sensitivity and unsurpassed stability, clarity and durability. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to employ an acoustic type touch screen in the display of patent claim 2 since some companies, e.g., Elo have developed such a touch screen as an desirable and competitive alternative to the resistive touch screen.

Prior Art Rejections

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kubes. Kubes, column 6, lines 17-33, column 10, lines 33-53 and column 11, lines 7-23 discloses an integrated top emitting organic electro-luminescent display on a plastic substrate which is covered by a clear protective sheet having a touch screen thereon. Thus claims 1-4, 8-12 and 16 are anticipated.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5, 7, 9, 10, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colgan in view of Hunter. Colgan discloses a capacitive type touch screen integrated with the glass substrate of a display device. Although Colgan primarily discloses a liquid crystal display, At column 14, lines 18-34, Colgan discloses that any display type have a matrix of display elements on one side of a substrate and a touch screen on the other side of the substrate can be made in an integrated fashion. Since an back emitting organic EL display such as taught by Hunter qualifies as a substrate having display elements on one side of the substrate and a second substrate surface free of layered material, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to integrate a touch screen with the organic electro-luminescent display of Hunter to provide the advantage of a touch screen with a EL display as suggested by the teaching of Colgan

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colgan and Hunter as applied to claim 1 above, and further in view of the September 1999 brochure by Elo company entitled "IntelliTouch Surface-Wave Touchscreens". Colgan, as above modified by Hunter, differs from the claimed invention in that a acoustic wave type touch screen rather than a resistive or other type touch screen, each of which is within the scope of patent claim 2. Also, it is disclosed by Elo that Surface Wave acoustic touch screens have high sensitivity and unsurpassed stability, clarity and durability. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to employ an acoustic type touch screen in the display of patent claim 2 since some companies, e.g., Elo have developed such a touch screen as an desirable and competitive alternative to the capacitive touch screen..

Allowable Subject Matter

Claims 17-25 are allowed. These claims are allowable over the prior art since the specific process steps are not taught or suggested by the prior art of record, particularly the steps of forming a touch screen by forming a flexible spacer layer having a plurality of spacer dots on a resistor layer, forming a flexible circuit layer over the flexible matrix with the spacer dots and providing a flexible protective layer over the flexible circuit layer (claims 17, 20 and 21), or forming a capacitive touch screen comprising a metal oxide layer having metal corner contacts attached to the oxide layer (claims 18, 22 and 23) or forming a surface wave touch screen by etching surfave acoustive wave reflection elements on one face of the substrate of cover sheet of an organic electro-luminescent display (claims 19, 24 and 25).

Directions for Responses

Any formal response to this communication should be directed to examiner Kenneth Ramsey, Art Unit 2879, at 703-308-2324.

If the examiner is not available the examiner's supervisor can be reached at 703-305-4794.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Kenneth J Ramsey

Kenneth Ramsey

kjr
December 15, 2003

KENNETH J. RAMSEY
PRIMARY EXAMINER